

REMARKS

Summary of the Office Action

In the Office Action, claims 1-10, 16, 18-21, and 31-35 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 5,554,094 to *Viens*.

In the Office Action, claim 11 stands rejected under 35 U.S.C. §103(b) as allegedly being unpatentable over U.S. Patent No. 5,554,094 to *Viens*.

Applicant respectfully traverses these rejections for the following reasons.

Summary of the Response to the Office Action

Applicant respectfully submits that the amended features of independent claims 1, 16, and 33 are not taught or suggested by the applied references of record. Claims 34 and 35 are cancelled without prejudice or disclaimer. Claims 12-15, 17, and 22-30 are withdrawn from consideration. Accordingly, claims 1-11, 16, 18-21, and 31-33 are pending for further consideration.

All Subject Matter Complies with 35 U.S.C. § 102(b)

In the Office Action, claims 1-10, 16, 18-21, and 31-33 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 5,554,094 to *Viens*. Applicant respectfully traverses the rejections for the following reasons.

Viens does not anticipate the present invention at least because *Viens* does not teach or suggest all the recited features of independent claims 1, 16, and 33. Applicants respectfully submit that the Z-folding of paper as described in *Viens* corresponds to the letter Z-folding of paper in the present invention. However, *Viens* does not additionally disclose a corresponding Z-folding of paper as recited in independent claims 1, 16, and 33. Thus, *Viens* does not anticipate

the present invention.

Viens does not disclose at least “a folding mode selecting device . . . [that] . . . selectively causes the sheet folding unit to operate one of the folding modes,” as recited in claims 1, 16, and 33. That is, there is no folding mode selecting device in *Viens* because *Viens* teaches that an operator or user manually changes each folding apparatus 12 to perform either Z-folding, C-folding, or half-folding of sheets. See at least col. 4, line 61 through col. 5, line 8 of *Viens*. Thus, the user cannot be the equivalent of an auto-folding mode selecting device.

The Office Action’s position correctly cites “the folding apparatus 12 is set up by the user.” See col. 4, line 64 of *Viens*. However, the Office Action states that “the ‘user’ could automatically select which folding mode to use as in column 4, lines 24 to 27.” See page 2 of the Office Action. This statement is completely without merit. Column 4, lines 24-27 of *Viens* actually states that “[a] computer processing unit (not shown) including two keyboard/monitor units 14A, 14B allows the user to track the operation of the system 10.” The citation from *Viens* does not support the Office Action’s assertion that a user could automatically select which folding mode to use. The tracking of a folding job by a computer as described in col. 4, lines 24-27 of *Viens* is not the same as “an auto-folding mode selecting device . . . [that] . . . selectively causes the sheet folding unit to operate one of a plurality of folding modes,” as recited in claims 1, 16, and 33, and as similarly recited in claims 34 and 35. Thus, the statement in the Office Action is erroneous.

Further, when you consider the Office Action’s statement that “the ‘user’ could automatically select which folding mode to use as in column 4, lines 24 to 27,” it is completely erroneous on its face. Consider the phrase, “the ‘user’ could automatically select.” The

dictionary states that “automatically” is defined as “[a]cting or done without volition or conscious control; involuntary: automatic shrinking of the pupils of the eyes in strong light.” See *The American Heritage Dictionary of the English Language*, Fourth Edition, 200, Houghton Mifflin Company. Therefore, the Office Action would have us believe that a user “without volition or conscious control” can select which folding mode to use. In other words, the user in *Viens* involuntarily selects a folding mode. This conclusion is completely ridiculous, but this is the position espoused by the Patent Office in the last few rejections.

In reality, *Viens* actually discloses three separate sheet folding apparatus 12 that have different folding sheet paths. Each sheet folding apparatus 12 can be exchanged to perform Z-folding, C-folding, and half-folding of sheets. The different sheet paths are shown in Figs. 5A-5B, 6A-6B, and 7A-7B, respectively. The sheet folding apparatus 12, and hence their sheet paths, are manually exchanged from one to another. See col. 1, lines 65-67; col. 4, line 61 through col. 5, line 8; col. 6, lines 29-35; and col. 8, lines 48-52 of *Viens*. There is no teaching in *Viens* of any “auto-folding mode selecting device” that causes an exchange or reconfiguration of the folding apparatuses. Thus, *Viens* teaches away from the present invention because *Viens* discloses sheet folding apparatus 12 with different sheet paths that must be manually exchanged to enable the Z-folding, C-folding, and half-folding of sheets. See col. 4, line 61 through col. 5, line 8; col. 5, line 9 through col. 8, line 30; and Figs. 5A-5B, 6A-6B, and 7A-7B of *Viens*.

In the present invention, the letter Z-folding, letter C-folding, and Z-folding of sheets require only a single configured sheet path. See at least page 12, lines 21-24 of the specification. All three types of sheet folding can be accomplished with one single sheet path configuration as seen in Fig. 3 of the specification. No alternate sheet paths are necessary and no manual

exchange of parts is needed to accommodate the different folding modes of the present invention.

Additionally, *Viens* does not disclose at least “the folding mode selecting device causes the folding position changing mechanism to change a sheet folding position in accordance with a selected one of the folding modes,” as recited in newly amended independent claims 1, 16, and 33. *Viens* performs the Z-fold on a product 28 by using a bypass device 91. The bypass device 91 is located in a fourth path after a nip 88 and deflects the product 28 into a nip formed between a roller 90 and a roller 96 (see Fig. 5A; col. 5, line 39 through col. 6, line 29). To the contrary, to perform a C-fold on the product 28, a bypass device 102 is mounted at a second station 66, and a buckle plate 104 is mounted in a third station 68 (see Figs. 6A and 6B; col. 6, line 30-34). It is clear from the figures in *Viens* that the bypass device 91 and the buckle plate 104 are mounted at positions where the bypass device 91 and the buckle plate 104 interfere with each other. Thus, when a mode is changed from the Z-fold to that C-fold, it appears necessary in *Viens* to move the bypass device 91 and then mount the buckle plate 104. In other words, the buckle plate 104 seems to be mounted manually, and an adjustable stop 106 also seems to be mounted manually. To the contrary, the amended independent claims 1, 16, and 33 recite that “the folding mode selecting device causes the folding position changing mechanism to change a sheet folding position in accordance with a selected one of the folding modes.” Accordingly, Applicant respectfully submits that newly amended independent claims 1, 16, and 33 are not anticipated.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicant respectfully asserts that the

rejection under 35 U.S.C. § 102(b) should be withdrawn because *Viens* does not teach or suggest each feature of independent claims 1, 16, and 33.

Additionally, Applicant respectfully submits that dependent claims 2, 4 -10, 18-21, and 31-32 are also allowable insofar as they recite the patentable combinations of features recited in claims 1, 16, and 33, as well as reciting additional features that further distinguish over the applied prior art.

All Subject Matter Complies with 35 U.S.C. § 103(a)

Claim 11 stands rejected under 35 U.S.C. § 103(a) as obvious over *Viens*. Applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness and therefore all rejections under 35 U.S.C. § 103(a) should be withdrawn.

To establish a *prima facie* case of obviousness, three basic criteria must be met (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations. All three criteria must be met to establish obviousness.

As demonstrated above, the Office Action has not established a *prima facie* case of obviousness at least because *Viens* does not teach or suggest all the recited features of independent claim 1. As pointed out in M.P.E.P. § 2143.03, "[t]o establish *prima facie* obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art". *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). Therefore, Applicant respectfully asserts that the third prong of *prima facie* obviousness has not been met.

Applicant respectfully asserts that independent claim 1 is distinguishable over the applied art. Therefore, claim 11, which depends from independent claim 1, is allowable at least because claim 1 is allowable, as well as for the additional features recited therein.

Applicant's representatives respectfully submit that the evidence is overwhelming that *Viens* does not disclose, teach, or suggest the above-mentioned features of the present invention. Therefore, Applicant's representatives respectfully request that the rejections under 35 U.S.C. § 102(b) and § 103(a) be removed and the application passed on to allowance. If there are any issues that remain or that may be answered by Applicant's representatives, the Examiner is invited to contact the Applicant's representatives before a first action on the merits.

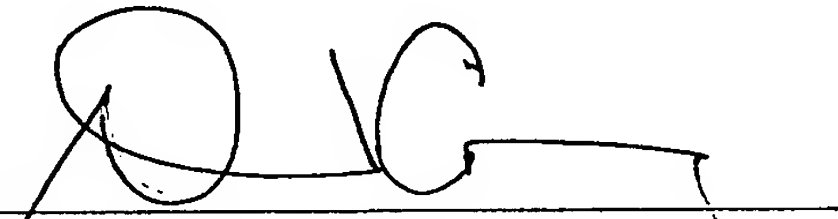
CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the Response, the Examiner is invited to contact the Applicant's undersigned representative to expedite prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

By: 
David E. Connor
Reg. No. 59,868

Dated: February 1, 2007

Customer No. 009629
MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, N.W.
Washington, DC 20004
Tel: 202-739-3000